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09/682,732	10/11/2001	Ron L. Blackburn	268/227	6545

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/682,732

Applicant(s)

BLACKBURN ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Election/Restriction***

1. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim, election was made without traverse in the telephone interview on 3/25/03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yant (6178644) in view of Brandon (4942679).

Yant shows an insert comprising a steel sheet (11), a cushion layer (21), orthopedic supports (32), and a top membrane (22) substantially as claimed except for the support being provided as part of the cushion layer. Brandon teaches forming a cushion layer (48) with orthopedic supports comprising a peripheral lip (53 and 54) and a metatarsal support (56) and the cushion layer is located between a rigid layer (35 and 36) and a top membrane layer (60). It would have been obvious to provide a shaped cushion layer as taught by Brandon for the cushion layer in the insert of Yant to increase support, comfort, and stability of the foot.

In reference to claims 6, 7, 15, and 21-23, Yant as modified above discloses the claimed invention except for the exact thickness of the steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use

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steel with a thickness of 0.02-0.025 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to claims 9 and 10, Yant as modified above discloses the claimed invention except for the exact material for the cushion layer, Brandon suggests the use of open cell foams. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use open cell polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

4. Claims 1-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates (UK 2264221) in view of Brandon (4942679).

Gates shows an insert comprising a steel sheet (8) and a cushion layer (9) substantially as claimed except for supports being provided as part of the cushion layer and a top membrane layer. Brandon teaches forming a cushion layer (48) with orthopedic supports comprising a peripheral lip (53 and 54) and a metatarsal support (56) and the cushion layer is located between a rigid layer (35 and 36) and a top membrane layer (60). It would have been obvious to provide a shaped cushion layer as taught by Brandon for the cushion layer in the insert of Gates to increase support, comfort, and stability of the foot.

In reference to claims 6, 7, 15, and 21-23, Gates as modified above discloses the claimed invention except for the exact thickness of the steel. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to use steel with a thickness of 0.02-0.025 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to claims 9 and 10, Gates as modified above discloses the claimed invention except for the exact material for the cushion layer, Brandon suggests the use of open cell foams. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use open cell polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

5. Applicant's arguments filed 8/28/03 have been fully considered but they are not persuasive.

It is noted that on page 3 applicant states that claims have been previously canceled, however no claims have been canceled in this application. It is noted that 5 claims have been withdrawn.

In response to applicants' arguments that Yant shows multiple steel sheets, this does not negate the fact that Yant does show a single sheet. The fact that a reference shows additional elements does not negate the fact that the reference does show all of the claimed elements.

In response to applicants' arguments directed towards the thickness of the sheet of steel, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been obvious to a skilled artisan to adjust the thickness of the steel sheet to obtain the desired strength, flexibility, weight, etc.

In response to applicants' arguments directed towards Brandon, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants' argument that how the references have been combined is unclear, the Examiner has explicitly explained such in the rejections above, it is not clear what further explanation is needed by applicant. In response to applicants' argument that the prior art does not provide textural basis, there is no requirement for such. The references clearly show and teach limitations, elements, etc..

In response to applicants' argument that claims 2-5, 8, and 11-14 were not addressed, this is not true. The examiner has clearly addressed and rejected all of the claims. For example the Examiner has specifically pointed out how and where the reference to Brandon teaches a metatarsal support region in a cushion layer (as noted in the rejections above as element 56) which is exactly what claim 2 claims. Applicants' arguments are not understood and are not accurate.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims

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or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson